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10/577,610	09/25/2006	Simcha Gendelman	4529/97323	5371

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EXAMINER
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KANERVO, VIRPI H

ART UNIT	PAPER NUMBER
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3691

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/577,610	<b>Applicant(s)</b> GENDELMAN, SIMCHA	
	<b>Examiner</b> VIRPI H. KANERVO	<b>Art Unit</b> 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17, and 19-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-14, 16-17, and 19-22, are presented for examination. Applicant filed Request for Continued Examination (RCE) on 10/27/2008 amending claims 1 and 11. In light of Applicant's amendments, Examiner withdraws the § 103 rejection of claims 1-14, 16-17, and 19-22. However, new grounds of § 103 rejection are established for claims 1-14, 16-17, and 19-22; and new grounds of § 101 rejection are established for claims 1-10 and 21-22. Examiner has fully considered Applicant's arguments directed to claims 1-14, 16-17, and 19-22, but they are moot in view of new grounds of rejection necessitated by Applicant's amendment of claims.

### ***Response to Arguments***

2. In light of Applicant's amendments, Examiner withdraws the rejection of claims 1-14, 16-17, and 19-22. However, new grounds of § 103 rejection are established. Applicant's arguments with respect to claims 1-14, 16-17, and 19-22, have been fully considered, but they are moot in view of new grounds of rejection necessitated by Applicant's amendment of claims.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-10 and 21-22 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is independent claim, and it is directed to method that is not linked to another statutory class, *i.e.*, it is directed to non-statutory subject matter. Method claim merely having another statutory class in preamble in absence of another statutory class does not render the claims statutory. Therefore, claim 1 is rejected as directed to non-statutory subject matter. Claims 2-10 and 21-22 depend from claim 1. None of the dependent claims 2-10 and 21-22 correct the non-statutory subject matter in claim 1. Therefore, claims 2-10 and 21-22 are also rejected for being directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in § 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-11, 14, and 20, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Knox (2002/0194122 A1) in view of Nhaissi (2005/0203835 A1).

As to claim 1, Knox shows issuing, by a prepaid card issuer, a multiplicity of prepaid cards (Knox: page 1, ¶ 17 and page 2, ¶ 18), each bearing prepaid card identification indicia (Knox: Fig. 1, labels 105 and 106); inputting the prepaid card identification indicia of a prepaid card into a point of sale terminal (Knox: Fig. 1, labels 105, 106, 110, and 111); and communicating said prepaid card identification indicia from the point of sale terminal to a remote server to validate said prepaid card (Knox: Fig. 1, labels 110, 111, and 150; and page 2, ¶ 18).

Knox does not show that following receipt of acceptable validation from said remote server, processing a prepaid card transaction as a credit card transaction employing a credit card account of said prepaid card issuer, which

credit card account is identified by a credit card number which is different from said identification indicia of said prepaid card. Nhaissi shows that following receipt of acceptable validation from said remote server, processing a prepaid card transaction as a credit card transaction employing a credit card account of said prepaid card issuer, which credit card account is identified by a credit card number which is different from said identification indicia of said prepaid card (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by following receipt of acceptable validation from said remote server, processing a prepaid card transaction as a credit card transaction employing a credit card account of said prepaid card issuer, which credit card account is identified by a credit card number which is different from said identification indicia of said prepaid card of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 2, Knox in view of Nhaissi shows all the elements of claim 1. Knox does not show charging said credit card account, identified by said credit card number, for the amount of said prepaid card transaction. Nhaissi shows charging said credit card account, identified by said credit card number, for the amount of said prepaid card transaction (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by charging said credit card account, identified by

said credit card number, for the amount of said prepaid card transaction of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 3, Knox in view of Nhaissi shows all the elements of claim 2. Knox also shows that said credit card account is charged for the amount of prepaid card transactions of at least a plurality of said multiplicity of prepaid cards (Knox: page 1, ¶ 17; and page 2, ¶ 18).

As to claim 4, Knox in view of Nhaissi shows all the elements of claim 2. Knox also shows that said credit card identification indicia is stored at said point of sale terminal (Knox: Fig. 1, labels 110 and 111). Knox does not show that said credit card identification indicia is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by said credit card identification indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 5, Knox in view of Nhaissi shows all the elements of claim 4. Knox also shows that said credit card identification indicia is accessed at said point of sale terminal using said prepaid card identification indicia (Fig. 1, labels 105, 106,

110, and 111). Knox does not show that said credit card identification indicia is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by said credit card identification indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 6, Knox in view of Nhaissi shows all the elements of claim 2. Knox also shows that said credit card identification indicia is stored at said remote server (Knox: Fig. 1, labels 110, 111, and 150; and page 2, ¶ 18). Knox does not show that said credit card identification indicia is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by said credit card identification indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 7, Knox in view of Nhaissi shows all the elements of claim 6. Knox also shows that said credit card number is accessed at said remote server using said prepaid card identification indicia (Knox: Fig. 1, labels 110, 111, and 150; and page 2, ¶ 18). Knox does not show that said credit card identification indicia



is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by said credit card identification indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 8, Knox in view of Nhaissi shows all the elements of claim 1. Knox also shows that said inputting comprises reading said prepaid card identification indicia (Knox: page 2, ¶ 18).

As to claim 9, Knox in view of Nhaissi shows all the elements of claim 1. Knox also shows that said inputting comprises keying in said prepaid card identification indicia (Knox: page 2, ¶ 18).

As to claim 10, Knox in view of Nhaissi shows all the elements of claim 1. Knox also shows that said acceptable validation comprises balance information (Knox: page 2, ¶ 18).

As to claim 11, Knox shows an input device operative to receive prepaid card identification indicia from a prepaid card issued by a prepaid card issuer (Knox: Fig. 1, labels 105, 106, 110 and 111).

Knox does not show a processor, operative to process a prepaid card transaction using the prepaid card as a credit card transaction employing a credit card account of said prepaid card issuer, which credit card number which is different from said prepaid card identification indicia. Nhaissi shows a processor, operative to process a prepaid card transaction using the prepaid card as a credit card transaction employing a credit card account of said prepaid card issuer, which credit card number which is different from said prepaid card identification indicia (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by a processor, operative to process a prepaid card transaction using the prepaid card as a credit card transaction employing a credit card account of said prepaid card issuer, which credit card number which is different from said prepaid card identification indicia of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 14, Knox in view of Nhaissi shows all the elements of claim 11. Knox also shows that said processor is operative to verify acceptable validity of said prepaid card identification indicia prior to processing said prepaid card transaction (Knox: page 2, ¶ 18).

As to claim 20, Knox in view of Nhaissi shows all the elements of claim 11. Knox does not show that said point of sale terminal receives said credit card

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number from a remote server. Nhaissi shows that said point of sale terminal receives said credit card number from a remote server (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox by said point of sale terminal receiving said credit card number from a remote server of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

7. Claims 12-13, 16-17, and 19, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Knox in view of Nhaissi, and further in view of Wu (2003/0046249 A1).

As to claim 12, Knox in view of Nhaissi shows all the elements of claim 11. Knox in view of Nhaissi does not show that said input device is a card reader. Wu shows that said input device is a card reader (Wu: page 3, ¶ 34). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Nhaissi by said input device being a card reader of Wu in order to provide means for reading the data contained on the prepaid card (Wu: page 3, ¶ 34).

As to claim 13, Knox in view of Nhaissi shows all the elements of claim 11. Knox in view of Nhaissi does not show that said input device is a keyboard. Wu shows that said input device is a keyboard (Wu: page 3, ¶ 34). It would have been

obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Nhaissi by said input device being a keyboard of Wu in order to permit the customer to input information concerning the purchase of the prepaid card (Wu: page 3, ¶ 34).

As to claim 16, Knox in view of Nhaissi shows all the elements of claim 11. Knox in view of Nhaissi does not show a communicator, operative to communicate said prepaid card identification indicia to a remote server to determine validity of said prepaid card. Wu shows a communicator, operative to communicate said prepaid card identification indicia to a remote server to determine validity of said prepaid card (Wu: page 3, ¶ 34). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Nhaissi by a communicator, operative to communicate said prepaid card identification indicia to a remote server to determine validity of said prepaid card of Wu in order to permit the network interface device of the terminal to communicate and connect with authorized remote servers located on the global communications network such as Internet (Wu: page 3, ¶ 34).

As to claim 17, Knox in view of Nhaissi shows all the elements of claim 16. Knox in view of Nhaissi does not show that said remote server is operative to communicate a balance in said prepaid card, via said communicator, to said terminal. Wu shows that said remote server is operative to communicate a

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balance in said prepaid card, via said communicator, to said terminal (Wu: Fig. 2; and page 4, ¶¶ 40-41). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox in view of Nhaissi by said remote server being operative to communicate a balance in said prepaid card, via said communicator, to said terminal of Wu in order to permit the network interface device of the terminal to communicate and connect with authorized remote servers located on the global communications network such as Internet (Wu: page 3, ¶ 34).

As to claim 19, Knox in view of Nhaissi shows all the elements of claim 11. Knox does not show a storage device for storing said credit card identification indicia. Wu shows a storage device for storing said credit card identification indicia (Wu: page 3, ¶ 34). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Knox by a storage device for storing said credit card identification indicia of Wu in order to permit the network interface device of the terminal to communicate and connect with authorized remote servers located on the global communications network such as Internet (Wu: page 3, ¶ 34).

Knox in view of Wu does not show that said credit card identification indicia is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have

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modified the system of Knox in view of Wu by said credit card identification indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

8. Claims 21 and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Knox in view of Nhaissi, and further in view of Meier (2003/0102376 A1).

As to claim 21, Knox in view of Nhaissi shows all the elements of claim 5. Knox does not show identifying said credit card indicia by accessing a lookup table based on said prepaid card identification indicia. Meier shows identifying said credit card indicia by accessing a lookup table based on said prepaid card identification indicia (Meier: page 2, ¶ 29). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by identifying said credit card indicia by accessing a lookup table based on said prepaid card identification indicia of Meier in order to provide card identifier indicator (Meier: page 1, ¶ 8).

Knox in view of Meier does not show that said credit card identification indicia is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox in view of Meier by said credit card identification

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indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

As to claim 22, Knox in view of Nhaissi shows all the elements of claim 7. Knox does not show identifying said credit card indicia by accessing a lookup table based on said prepaid card identification indicia. Meier shows identifying said credit card indicia by accessing a lookup table based on said prepaid card identification indicia (Meier: page 2, ¶ 29). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox by identifying said credit card indicia by accessing a lookup table based on said prepaid card identification indicia of Meier in order to provide card identifier indicator (Meier: page 1, ¶ 8).

Knox in view of Meier does not show that said credit card identification indicia is the credit card number. Nhaissi shows that said credit card identification indicia is the credit card number (Nhaissi: page 17, ¶ 276). It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the method of Knox in view of Meier by said credit card identification indicia being the credit card number of Nhaissi in order to allow the user to access the Internet anonymously (Nhaissi: page 1, ¶ 7).

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Cohen (6,505,171 B1) discloses system and method for handling purchasing transactions over a computer network.

Dowens (7,333,596 B1) discloses casual usage alternate billing.

Foss (7,325,725 B2) discloses stored value card account transfer system.

Marchand (6,636,592 B2) discloses system and method for using bad billed number records to prevent fraud in telecommunication system.

Tarbutton (2001/0037209 A1) discloses pre-paid payment system and method for anonymous purchasing transactions.

Weinstein (2001/0026609 A1) discloses method and apparatus facilitating the placing, receiving, and billing of telephone calls.



10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VIRPI H. KANERVO whose telephone number is (571)272-9818. The examiner can normally be reached on Monday - Thursday, 8:00 a.m. - 5:00 p.m., EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Virpi H. Kanervo

/Alexander Kalinowski/

Supervisory Patent Examiner, Art Unit 3691